

JPW



PATENT  
Customer No. 22,852  
Attorney Docket No. 08130.0051-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
 )  
Martin SCHADT et al. ) Group Art Unit: 2871  
 )  
Application No.: 10/728,853 ) Examiner: Chowdhury, Tarifur Rashid  
 )  
Filed: December 8, 2003 )  
 )  
For: OPTICAL ELEMENT )  
 )  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO SPECIES ELECTION REQUIREMENT, WITH TRAVERSE**

In the Species Election Requirement mailed December 22, 2004, with a period for response extending to January 24, 2005 (January 22<sup>nd</sup> being a Saturday), the Examiner required election under 35 U.S.C. § 121 between the following asserted species: Species I (claims 32-48); Species II (claims 49-51); Species III (claims 52-56); Species IV (claim 57); and Species V (claim 58). Applicants hereby provisionally elect to prosecute Species I, comprising claims 32-48. Applicants election is made with traverse for the following reasons.

In the communication dated December 22, 2004, the Examiner asserted that the present application contains five "patentably distinct species" (i.e., Species I-V). Therefore, the Examiner concluded that election of one of these species is required under Section 121. However, the Examiner failed to provide any explanation of the basis for the election requirement and, in particular, the basis for supporting the identification or restriction of the species. The communication of December 22, 2004

simply includes a listing of the five species, without any explanation or support offered by the Examiner. For this reason, Applicants election is made with traverse and reconsideration and withdrawal of the election requirement is respectfully requested.

The Examiner has also failed to demonstrated that a serious burden would exist if the Examiner was required to consider the non-elected claims (Species II-V) along with the claims of Species I. There are only ten non-elected claims (claims 49-58). Furthermore, a search for prior art with respect to Species I would likely overlap with a proper search for that of Species II-V. For this additional reason, Applicants election is made with traverse and reconsideration and withdrawal of the election requirement is respectfully requested.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: January 21, 2005

By: 

C. Gregory Gramenopoulos  
Reg. No. 36,532